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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,157	01/29/2001	Edward F. Tokas	IR-2588(ET)CIP	8701

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,157

Applicant(s)

TOKAS ET AL.

Examiner

Geoffrey L. Knable

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9-33, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-28-2005 has been entered.
2. Claims 6 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made without traverse in the replies filed on 12-12-2003 and 7-28-2004.
3. Claims 21-33 and 49 have been rejoined with the elected grouping in view of the amendments to claim 21 as noted by applicant.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 21-33 and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In newly rejoined claim 21, it is not clear how the metathesizable material from step (b) relates to step (c) or the "bonding" described in the preamble, it being noted that as presently drafted, it would not appear that the metathesizable material is cooperating in effecting the bond since step (c) defines that the fiber substrate is contacted with the elastomer and not the metathesizable material (this being contrary to

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the apparent intent). Clarification is therefore required of the role of the metathesizable material in the bonding.

6. Claims 1-5, 7, 10, 16-21, 26-32, 49 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 424833 to Goodall et al. taken in view of Suzuki et al. (US 5,137,785).

Both of these references were applied in the previous office action but they are reversed in this new rejection, i.e. now EP '833 is the primary reference in view of the amendments to the claims. Thus, EP '833 discloses forming reinforced molded articles by providing a catalyst at/on a surface of a fibrous substrate article (e.g. a fiber mat), this catalyst being then contacted with a metathesizable material in a mold so that the metathesizable material undergoes a metathesis reaction. Bonding to a second substrate article is not however suggested. Suzuki et al. discloses that it is desirable to provide surface layers of an olefin polymer or thermoplastic elastomer to a molded norbornene based resin formed by metathesis polymerization, the bond to the surface layers being effected in a mold by the metathesis polymerization (e.g. note cols. 1-2, esp. col. 2, lines 9+). To provide a molded article as in EP '833 with the desirable surface layers ("second substrate") taught by Suzuki et al., these being formed in situ by first positioning the surface layer(s) in the mold, would therefore have been obvious and lead to a desirable end product as taught by Suzuki et al. As to the dependent claims, the references are applied for substantially the same reasons as described in the last office action. The newly rejoined claims are essentially analogous to previous claims and are rejected for the same reasons.

7. Claims 11-15, 22-25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 424833 to Goodall et al. taken in view of Suzuki et al. (US 5,137,785) as applied above, and further in view of the admitted state of the prior art as applied in the last office action.

8. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note the last office action.

9. Applicant's arguments filed 10-28-2005 have been fully considered but they are not persuasive and are mostly moot in view of the newly formulated grounds of rejection.


The arguments with respect to the rejection based upon JP '636 are however convincing and this rejection has been withdrawn.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
January 7, 2006